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In re Application of:
David William Holden
Serial No.: 09/714,602
Filed: November 16, 2000
Attorney Docket No.: RPMS 101 CON 3

DECISION ON PETITION

This is in response to applicant's petition under 37 CFR § 1.181 sent by facsimile transmission on March 10, 2004, requesting review of the Examiner's assertions for denying applicant's right of priority to parent applications 09/201,945 and 08/637,759.

BACKGROUND

Applicant filed this application which is a continuation application of 09/201,945 and 08/637,759. The examiner issued a first Office action on November 17, 2003 rejecting the instant claims under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The examiner additionally denied priority of the instant application to the parent applications recited above because the conditions of 35 USC 120 have not been satisfied.

DISCUSSION

Applicant states that this application is a continuation of 09/201,945 and 08/637,759 and that the specification of the priority applications is identical to the specification of the present application. Applicant further states that while the examiner can question the enablement of the specification of the claims on appeal, he cannot deny priority since the specifications are identical.

A review of the application establishes that there is no disclosure in the 09/201,945 or 08/637,759 applications of the broadly claimed methods recited in the pending claims. The earlier applications were specifically limited to methods of identifying genes where the methods comprise insertional inactivation of genes within the genome of a target microorganism (e.g. a pathogen) with transposon elements (or "transposon-like" elements) comprising a unique nucleic acid tag sequence. The instant claims recite methods that are not reliant upon insertional inactivation of genes by a transposon or "transposon-like" element, nor do they necessarily depend upon a comparison of the unique tag sequences isolated from surviving microorganism to those initially introduced into the particular environment (e.g.

claims 57 and 86). Therefore, the pending claims encompass embodiments that are not encompassed by the earlier applications. Accordingly, applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 USC 120 since the instant application must be an application for a patent for an invention which is also disclosed in the prior application; the disclosure of the invention in the parent application and in the later filed application must be sufficient to comply with the requirements of the first paragraph of 35 USC 112. See MPEP 201.11 (I. Written Description).

DECISION

For the reasons set forth above, applicant's right of priority is denied and applicant's petition is **DENIED**.

Upon review of the Office action, it was noted that the examiner indicated applicant had submitted a preliminary amendment on the filing date of the instant application comprising the pending claims and recited subject matter and that, therefore, the pending claims do not constitute new matter. However, MPEP 601.01(a) states if an amendment is filed on the same day that the application filed under 37 CFR 1.53(b) is filed and is referred to in the original oath or declaration filed with or after the application, it constitutes a part of the original application papers and the question of new matter is not considered. Therefore, to avoid the question of new matter in the instant application, applicant should submit a new oath or declaration referring to the preliminary amendment.

This application will be forwarded to the examiner for consideration of the amendment of May 24, 2004.

Should there be any questions about this decision, please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile at 703-872-9306.



Jasmine C. Chambers
Director, Technology Center 1600